



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,655	12/11/2003	Christian Peter Behrenbruch	KEMP-011	8976
24353	7590	09/06/2005	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/734,655	BEHRENBRUCH ET AL.	
	Examiner	Art Unit	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-10 and 18-20**, are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al U.S. Patent No. 6,088,804.

1. As per **claim 1**, Hill et al discloses a processing system comprising an processing apparatus and a processing agent, the processing agent being administrable to a processing subject and having in relation thereto a primary behaviour effective in combination with said processing apparatus to achieve a desired process result, wherein the processing agent further has a distinctive signature characteristic distinguishing it from other processing agents, and wherein the processing system comprises test functionality to test for the distinctive signature characteristic of the processing agent and selectively to modify subsequent operation of the processing apparatus based on the test result(fig. 1, 2 and 7; col. 4, lines 62-67; col. 5, lines 1-5, 46-65; col. 9, lines 35-45).

2. As per **claim 2**, Hill et al further discloses a processing system, wherein the test

Art Unit: 3621

functionality is effective to disable, at least partially, subsequent operation of the processing apparatus in the absence of said distinctive signature characteristic (col. 7, lines 40-45; col. 8, lines 50-58).

3. As per **claim 3**, Hill et al further discloses a processing system wherein the test functionality is effective to disable, at least partially, output of the process result in the absence of said distinctive signature characteristic (col. 7, lines 40-45; col. 8, lines 50-58).

4. As per **claim 4**, Hill et al further discloses a processing system, wherein the processing agent comprises a first component for providing said primary behaviour and a second component having said distinctive signature characteristic (fig. 5 and 7; col. 4, lines 62-67; col. 5 lines 1-15, 39-45).

5. As per **claim 5**, Hill et al further discloses a processing system, wherein the distinctive signature characteristic is in the behaviour of the processing agent in the processing subject (col. 5, lines 45-65).

6. As per **claim 6**, Hill et al further discloses a processing system, wherein the distinctive signature characteristic is in the time-dependent behaviour of the processing agent in the processing subject (col. 2, lines 24-60; col. 5, lines 26-37).

7. As per **claim 7**, Hill et al further discloses a processing system wherein the distinctive signature characteristic is in the spatially-dependent behaviour of the processing agent in the processing subject (col. 8, lines 39-49).

8. As per **claim 8**, Hill et al further discloses a processing system, wherein the distinctive signature characteristic is a property of the processing agent detectable by the processing apparatus (fig. 2 and 5; col. 3, lines 18-40).

9. As per **claim 9**, Hill et al further discloses a processing system, wherein the processing apparatus comprises an analysis apparatus, the processing agent comprises an analysis agent and the processing subject is an analysis subject, the analysis agent being administrable to the analysis subject and having in relation thereto a primary behaviour effective to reveal upon analysis by the analysis apparatus a condition of the analysis subject as said process result (fig. 1; col. 1, lines 59-67; col. 2, lines 12-20, 24-35).

10. As per **claim 10**, Hill et al further discloses an analysis system, wherein the distinctive signature characteristic is a property of the processing agent detectable by the analysis apparatus on analysis of the primary behaviour of the analysis agent (fig. 1; col. 1, lines 59-67; col. 2, lines 12-20, 24-35; col. 3, lines 18-40).

18. As per **claim 18**, Hill et al further discloses a computer program comprising

Art Unit: 3621

program code means for providing on a programmed data processor test functionality for use in a processing system (fig. 1; col. 5, lines 7-15).

19. As per **claim 19**, Hill et al further discloses a computer program further comprising program code means for controlling said processing apparatus to achieve said desired process result (col. 4, lines 62-67; col. 5, lines 1-15; col. 9, lines 35-45).

20. As per **claim 20**, Hill et al further discloses a processing agent for use in a processing system and having in relation to a predetermined processing subject a primary behaviour effective in combination with said processing apparatus to achieve a desired process result, and further having a distinctive signature characteristic distinguishing it from other processing agents and distinguishable by said test functionality (fig. 1; col. 4, lines 62-67; col. 5, lines 1-15; col. 9, lines 35-45).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 11, 14, 15 and 16**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al U.S. Patent 6,088,804 in view of Ochs et al U.S. Patent Application Publication 2004/0111220.

11. As per **claim 11**, Hill et al failed to explicitly disclose an analysis system wherein the analysis apparatus is a medical imaging apparatus and the analysis agent comprises a contrast agent.

Ochs et al discloses an analysis system wherein the analysis apparatus is a medical imaging apparatus and the analysis agent comprises a contrast agent (0142).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the analysis apparatus is a medical imaging apparatus and the analysis agent comprises a contrast agent as taught by Ochs et al et al in order to archive economic advantage by expanding use for the system.

14. As per **claim 14**, Hill et al failed to explicitly disclose an analysis system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent.

Ochs et al discloses an analysis system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent (0172).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the distinctive signature characteristic is the magnetic resonance spectrum of the contrast agent as taught by Ochs et al et al in order to archive economic advantage

Art Unit: 3621

by expanding use for the system.

15. As per **claim 15**, Hill et al failed to explicitly disclose an analysis system wherein the analysis agent comprises the contrast agent and a further component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic.

Ochs et al discloses an analysis system wherein the analysis agent comprises the contrast agent and a further component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic (0172; claim 7).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the analysis agent comprises the contrast agent and a further component having a distinctive magnetic resonance spectrum to provide said distinctive signature characteristic as taught by Ochs et al et al in order to achieve economic advantage by expanding use for the system.

16. As per **claim 16**, Hill et al failed to explicitly disclose a processing system wherein the processing subject is a human being, plant or animal.

Ochs et al discloses a processing system wherein the processing subject is a human being, plant or animal (0179; 0182).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system



Art Unit: 3621

wherein the processing subject is a human being, plant or animal as taught by Ochs et al et al in order to archive economic advantage by expanding use for the system.

**Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al U.S. Patent 6,088,804 in view of Ochs et al U.S. Patent Application Publication 2004/0111220 as applied to claim 11 above, and further in view of Drukier et al U.S. Patent 6,225,132.

12. As per **claim 12**, both Hill et al and Ochs et al failed to explicitly disclose an analysis system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic.

Drukier et al discloses an analysis system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic (col. 12, lines 54-67; col. 13, lines 55-67; col. 14, lines 1-14).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the analysis agent comprises two radio isotopes of different decay characteristics to provide said distinctive signature characteristic as taught by Drukier et al in order to show expanded use of such system.

13. As per **claim 13**, Hill et al and Ochs et al failed to explicitly disclose an analysis

Art Unit: 3621

system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic.

Drukier et al discloses an analysis system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic (col. 12, lines 54-67; col. 13, lines 55-67; col. 14, lines 1-14).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the analysis agent comprises a component emitting photons of a particular energy to provide said distinctive signature characteristic as taught by Drukier et al in order to archive economic advantage by expanding use for the system.

**Claims 17**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al U.S. Patent 6,088,804 in view of Wong et al U.S. Patent 6,264,948.

17. As per **claim 17**, Hill et al failed to explicitly disclose a processing system wherein the processing subject is in vitro.

Wong et al discloses a processing system wherein the processing subject is in vitro (col. 11, lines 40-56).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hill et al and incorporate the system wherein the processing subject is in vitro as taught by Wong et al in order to archive

Art Unit: 3621

economic advantage by expanding use for the system.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

**Washington D.C. 20231**

Or faxed to:

Art Unit: 3621

**(571) 273-8300.** [Official communications; including After Final communications labeled "Box AF"].

**(571) 273-8300.** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

Hand delivered responses should be brought to the Examiner in the Knox Building, 50  
Dulany Street Alexandria VA.

acc  
August 30, 2005

**MARY D. CHEUNG**  
**PRIMARY EXAMINER**

A handwritten signature in cursive script, appearing to read "Mary D. Cheung", written in black ink.